

PETITIONS BRANCH

IN THE

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of
BEDALOV, et al
Application No.: USSN 09/677,592
For: Targeting Cells Having MAD2 Mutation
for Treatment and/or Prevention of Disease

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PETITION FOR RECONSIDERATION OR, IN THE ALTERNATIVE PETITION TO FIX FILING DATE AS OCTOBER 2, 2000

On December 20, 2000, Applicants (hereinafter "Petitioner") filed a petition to fix the filing date of Application No. USSN 09/677,592 ("Application") as October 2, 2000 ("Petition").¹ On March 15, 2001, the Commissioner, acting through the PCT Legal Office, (hereinafter "USPTO") issued a decision which declined to consider the Petition insofar as it applied to the Application ("Decision").² Petitioner respectfully requests that the Commissioner reconsider the Decision or, in the alternative, to act as an initial matter to fix the filing date of the Application as October 2, 2000.³

BACKGROUND

In the Decision, the USPTO noted that the Petition as filed on December 20, 2000 was formatted as "a single petition for twelve separate applications." (Decision at 1). Finding

¹A copy of the Petition is incorporated herein and attached hereto as Attachment A.

²A copy of the Decision is attached hereto as Attachment B.

³If the USPTO decides that any administrative fees should be assessed on this pleading, please charge any such fee payment to Deposit Account No. 50-0436.

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this format “contrary to 37 C.F.R. § 1.4(b),”⁴ the USPTO considered the Petition “with respect to the first identifiable application only.” Id. The USPTO went on to state that “[i]f applicant desires consideration of the applicable issues with respect to the other eleven applications, separate petitions must be filed, wherein each petition clearly identifies the application number to which it is directed.” Id.

The reason the Petition was formatted to apply to all twelve applications is that -- at the time of filing of the Petition -- the USPTO’s docketing process had not yet assigned application numbers to five of the twelve applications. Petition, V.S. Pouliquen at 1-2. As noted in the Decision, however, the USPTO had mailed a Notification on October 25, 2000 with respect to one of the applications -- International Application No. PCT/US00/27462. Thus the concern arose that under Rule 181(f), a petition to fix the filing date as October 2, 2000 for each of the twelve applications would be due two months after the date of the Notification despite the fact that five of the applications had not yet been assigned application numbers. 37 C.F.R. § 1.181(f). To avoid a “Catch-22” situation, one petition was filed covering all twelve applications.

The Petition was filed under Rule 182 and Rule 183. 37 C.F.R. §§ 1.182 and 1.183. Rule 4(b) was not contemplated to apply to a situation where an application number does not exist. Thus the USPTO has authority under Rule 182 to accept the Petition as applied to all

⁴Rule 1.4(b) provides in relevant part:

Since each file must be complete in itself, a separate copy of every paper to be filed in a patent or trademark application, patent file, trademark registration file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical.

twelve applications. Even if Rule 4(b) was meant to be applied to the situation herein, the provisions of Rule 4(b) would be overcome by Rule 183.

Accordingly, Petitioner requests that the Commissioner reconsider its Decision and act to fix the filing date of the Application as October 2, 2000. In the alternative, Petitioner requests that the Commissioner act as an initial matter to fix the filing date of the Application as October 2, 2000.

DISCUSSION

Petitioner argued in the Petition that the filing date of the Application should be fixed as October 2, 2000 under 37 C.F.R. § 1.182 & 1.183 (hereinafter Rule 182 and Rule 183). The USPTO has authority under Rule 182 to decide the Petition “in accordance with the merits of [the Petitioner’s] situation.” 37 C.F.R. § 1.182. And the USPTO has authority to “suspend[] or waive[]” any “requirement of the regulations in [Title 37, Part 1 of the Code of Federal Regulations] which is not a requirement of the statutes.” 37 C.F.R. § 1.183. For the reasons set forth in the Petition, the USPTO should exercise its authority under either Rule 182 or Rule 183 to fix the filing date of the Application as October 2, 2000.

Section 21(a) of Title 35 of the United States Code empowers the USPTO to consider an application to be filed with it “on the date on which it was deposited with the United States Postal Service.” 35 U.S.C. § 21(a).⁵ As explained in the Petition, the Commissioner has statutory authority under this provision to fix the filing date here as October 2, 2000 for two principal reasons. (Petition at 13-14).

⁵Otherwise, the “filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.” 35 U.S.C. § 111(a)(4).

First, the actions of Mr. Bennett at the Honolulu International Airport Post Office constitute deposit of the Application with the United States Postal Service in Hawaii on October 2, 2000. Mr. Bennett arrived at the Honolulu International Airport Post Office at 11:40 pm on October 2, 2000. He remained on the Post Office premises and diligently proceeded to complete the mechanics of filling out Express Mail address labels, purchasing and affixing postage, and physically placing the six packages (each containing a domestic and a corresponding PCT application) in the Express Mail drop box. In the circumstances of this case, as described in the Petition, Mr. Bennett's actions should be deemed to constitute Express Mail deposit of each of the six packages (twelve applications) on October 2, 2000.


Second, it is undisputed that all six packages (twelve applications) were physically within the Honolulu International Airport Express Mail drop box by 12:20 am on October 3, 2000. However, this point in time was 11:20 pm on October 2, 2000 in another United States Postal Service office location -- i.e., American Samoa[?]. Thus, the packages were in the physical custody of the United States Postal Service on October 2, 2000 viewed from an American Samoan reference point. This is sufficient for October 2, 2000 to be determined as "the date on which [the six packages (twelve applications)] w[ere] deposited with the United States Postal Service." 35 U.S.C. § 21 (a).



CONCLUSION

For the foregoing reasons, the USPTO should reconsider its Decision and act to fix the filing date of the Application as October 2, 2000.

Respectfully submitted,



Gilberto M. Villacorta, Ph.D.
Registration No. 34,038

Pepper Hamilton LLP
600 Fourteenth Street, N.W.
Washington, DC 20005-2004
Telephone: (202) 220-1200
Facsimile: (202) 220-1665

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